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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/746,754

12/21/2000

Randall G. Smith

POLY8

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EXAMINER

BHAT, ADITYA S

ART UNIT

PAPER NUMBER

2863

MAIL DATE

DELIVERY MODE

02/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/746,754 | SMITH ET AL. | |
| | Examiner | Art Unit | |
| | Aditya S. Bhat | 2863 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 46-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 46-48 and 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over (May 1998 SMART board product manual).

Regarding independent claim 46, SMART Board discloses all of the claimed subject matter except for projecting an image onto the whiteboard to occur *directly after* initiating the calibration process (i.e., Step 1).

Regarding independent claim 50, SMART Board discloses all of the claimed subject matter except for projecting a calibration image onto the whiteboard to be *directly preceded by* signaling the whiteboard system to project the calibration image (i.e., Step 1).

Although Steps 2-4 of the orientation procedure of SMART Board (associated with previewing and selecting the desired orientation level) occur between Step 1 and the image displayed prior to Step 5, providing a *single, default orientation level* in lieu of multiple orientation levels would have been a modification well within the level of ordinary skill in the art. That is, providing a single, default orientation level in SMART

Board would automatically launch the calibration image using a predefined orientation level directly after Step 1 (i.e., effectively bypassing Steps 2-4).

As a result, the user would not need to preview the orientation levels and select a desired orientation level (i.e., Steps 2-4) each time the whiteboard is oriented -- a potentially cumbersome process for users that consistently select the same orientation level. In short, this default feature would bypass Steps 2-4 and therefore display the calibration image (i.e., the image displayed just prior to Step 5) directly after Step 1.

Therefore, it would have been obvious to the skilled artisan at the time of the invention to provide a default orientation level in the orientation procedure of SMART Board in lieu of selecting a desired orientation level from multiple levels. Such a feature would automatically launch the calibration image using a predefined orientation level, thereby obviating the need for users to perform a potentially cumbersome and time-consuming preview and selection process each time the whiteboard is oriented.

Regarding dependent claims 47-48 and 51-52, the scope and breadth of the "remote control" limitation simply does not preclude the whiteboard's pushbutton functionality of Step 1. After the button(s) are pushed in Step 1 of SMART Board's orientation procedure, the dialog box appears that prompts the user to pick the orientation level. Assuming that this dialog box appears at the computer, the very act of pushing the button, in effect, controls the display of this dialog box at the computer. Therefore, the whiteboard and its buttons effectively constitute a "remote control device" at least with respect to the computer.

Claims 49 & 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over (May 1998 SMART board product manual) in view of In re Lindberg, 93 USPQ 23 (CCPA 1952).

(May 1998 SMART board product manual) discloses the claimed invention except for a *handheld* remote control device. It should be noted that (May 1998 SMART board product manual) teaches a remote control device. (pages 27-28)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a handheld/portable remote control device, since it has been held that making an old device portable or movable without producing any new and unexpected result involves only routine skill in the art. In re Lindberg, 93 USPQ 23 (CCPA 1952).

Response to Arguments

Applicant's arguments filed 1/7/2008 have been fully considered but they are not persuasive.

Applicant is reminded that during patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

While the meaning of claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of

claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allowed. This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

In this instance applicant has made claim amendments and argues that the board rejection is improper. With regards to the claim amendments to the preamble of the independent claims, the claims were drafted in Jepson type format therefore the amendments are considered to be prior art. Regarding applicant's argument which states that modifying the SMART reference would destroy the intent of the reference by eliminating steps. The board was not eliminating steps but automating/consolidating them in the modification of the SMART board reference. Doing so would have been obvious to one of ordinary skill in the art as it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. In re Venner, 120 USPQ 192. Applicant goes on to argue that the board used impermissible hindsight in order to arrive at the new grounds of rejection. In response to applicant's argument that the board's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aditya S. Bhat whose telephone number is 571-272-2270. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached on 571-272-2269. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aditya Bhat
February 19, 2008

/John E Barlow Jr./
Supervisory Patent Examiner,
Art Unit 2863